

REMARKS

Applicants have carefully considered the Office Action dated February 9, 2004. Applicants respectfully disagree with the Examiner's interpretation of the word "housing" because they believe that a statement that something is "housed" means that it is housed within the housing. However, to avoid unnecessary controversy, applicants have amended claim 1 to add the word "therein" such that the relevant portion of the claim reads as follows:

"the housing configured for housing the clip and releasably holding the clip
therein"

It is believed that the addition of the word "therein" does not change the scope of the claim one iota, but it is also believe that this amendment overcomes the examiner's objection to the wording of claim 1 and plainly distinguishes claim 1 from the Green reference which does not disclose a housing which holds the clip in the housing for the reasons explained in applicants amendment filed December 19, 2003, the entirety of which is incorporated by reference herein.

The examiner has also taken the position that the clip of Green is shaped like a ring and has made reference to Figure 4 thereof. However, it is plain from the disclosure and drawings of Green, e.g., Figures 2 and 17, that the clip of Green has a clam shell configuration and thus is not a ring, but rather is like a set of jaws which can open and close. Applicants recognize that an argument could be made that the clip of Green has a purportedly "annular" shape when the jaws are closed, as shown in Figure 4, but respectfully submit that it is an improper distortion of Green to characterize his clip as annular in the sense recited in the claims of the present application. Furthermore, and more importantly, even if the clip of Green is considered to be annular, it is not held within a housing as recited in claim 1 as amended and in claims 46, 55 and 60.

Turning now to the claim rejections, claim 1-9, 11 and 16 have been rejected as being anticipated by Green European Patent 0 774 237. In order for claims to be anticipated, each and every element of the claims must be disclosed in the reference, in re Paulson 30 S.3rd 1475, 31 U.S.P.Q. 2nd 1671 (Fed. Cir. 1994). Claim 1 has now been amended in conformity with claims 46, 55 and 60 all of which recite that the clip is contained within the housing. Thus, Green does not anticipate claims 1-9, 11 and 16, as amended, just as it does not anticipate claims 46, 50 and

66, and the claims dependent thereon. In addition, contrary to the examiner's characterization, element 34 of Green is not a housing, but, as is plain from Figure 2, is an elongate member which carries, not houses, clip 22. Thus, element 34 of Green, is somewhat comparable to sheath 12 of the present application in that the clip of Green and applicants' clip are carried by, respectively, "support structure 34" and sheath 12. Plainly, support structure 34 of Green is not a housing for the clip.

Furthermore, support structure 34 of Green is not "actuatable for advancing the clip distally toward the distal end of Green's device, but rather it is pusher tube 42 which advances the clip 22 of Green. As stated at column 7, lines 21-26, clip support structure 34 is simply the extension of support shaft 30 and is not, contrary to the examiners assertion, either slidable or disposed on the exterior of support shaft 30. Thus, what it boils down to is this:

1. Support structure 34 of Green is not a "housing" but rather an elongate member which carrier clip 22.
2. Support structure 34 of Green is not slidable over anything.
3. Support structure 34 of Green is utterly incapable of causing clip 22 to move in an axial direction (pusher tube 42 does this) and is not, contrary to the examiner's assertion, actuatable for advancing the clip toward the distal end of the device.

Far from anticipating claims 1-9, 11 and 16, the Green reference is fundamentally remote from the device recited in these claims.

The Hathaway patent says nothing to remedy deficiencies of Green. Hathaway is directed to a suturing member. The portion of Hathaway's device illustrated in Figure 18 is a suture snagger or grabber, not a locating device. As disclosed at Column 11, lines 5-64 of Hathaway, it is a series of sutures snagging and grabbing mechanisms which are described with reference to Figures 18-21. The examiner makes reference to column 10 of Hathaway which has nothing to do with Figure 18, but does discuss the irrelevant snagging mechanism of Figures 17a-17d. Compression spring 177a is discussed in column 10, but with regard to the structure of Figure

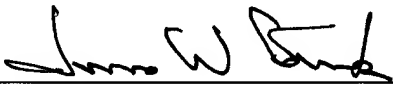
17a-17d, not Figure 18. Furthermore, compression spring 177a is illustrated in Figure 16b, not Figure 18.

In any event, the springs illustrated in Figure 16b cause handle 175 to move rearwardly when pin 276a is disengaged and tubular member 263b to remain in place until the compression of spring 177a is overcome by forward movement of the handle. All of this has manifestly absolutely nothing to do with the present application or with Green. Suture snagging and clip delivery are two totally nonanalogous arts and Hathaway cannot be properly combined with Green. Furthermore, even if Hathaway were somehow combined with Green, the resulting structure, in addition to being useless, would have nothing to do with the device claimed in the present application and, very particularly, nothing with the device claimed in claims 10, 13-15, 17-18 and 46-66. The prior art references cited in this application, neither anticipate nor render obvious any of the claims. It is respectfully submitted that the present amendment should be entered and that all of the claims in this case should be allowed.

Respectfully submitted,

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